

1 REMARKS

2 Status of the Claims

3 Claims 1-56 are now pending in the present application; Claims 57-61 having been
4 previously canceled. Claims 1, 13, 14, 21, 35, and 42 are amended to more particularly point out
5 and claim the subject matter considered novel by applicants in light of the cited art.

6 Notice of Non-Compliant Amendment dated April 19, 2006

7 In the above-referenced Notice of Non-Compliant Amendment, the Examiner indicated that
8 Claim 1 was identified as being "Previous Presented," when the claim clearly is being amended in
9 the Preliminary Amendment submitted with an RCE on January 9, 2006. However, it appears that
10 the Examiner is mistaken, since as submitted, the amendment to Claim 1 was indeed properly
11 identified as "Currently Amended." It is possible that the Examiner may have intended to refer to
12 Claim 14 of the January 9, 2006 Preliminary Amendment, which indeed was improperly identified
13 as "Previously Presented" although it included an amendment. Applicants have submitted this
14 corrected set of amendments and now request that the Examiner reconsider the application. Since
15 the Amendment noted as being non-compliant was submitted with an RCE, applicant is entitled to
16 file this corrected compliant response within one month of the Notice of Non-Compliant
17 Amendment being mailed, without paying any extension fee.

18 Claims Rejected Under 35 U.S.C. § 102(e)

19 In the Final Office Action dated August 25, 2005, the Examiner rejected Claims 1-3, 7, 10,
20 12-15, 19, 21, 22, 29, 31, 32, 35, 38, 40-43, 50, 52, and 53 under 35 U.S.C. § 102(e) as being
21 anticipated by U.S. Patent Application No. 2001/0010059 (Burman et al., which is hereinafter
22 referred to as "Burman"). The Examiner considered applicants' arguments and amendment filed on
23 May 16, 2005, but was not persuaded. Applicants respectfully request that the Examiner reconsider
24 the claims in this application in view of the above amendments to the claims and the following
25 discussion.

26 In the interest of reducing the complexity of the issues for the Examiner to consider in this
27 response, the following discussion focuses on independent Claims 1, 13, 14, 21, 35, and 42, all as
28 amended. The patentability of each remaining dependent claim is not necessarily separately
29 addressed in detail. However, applicants' decision not to discuss the differences between the cited
30 art and each dependent claim should not be considered as an admission that applicants concur with

1 the Examiner's conclusion that these dependent claims are not patentable over the disclosure in the
2 cited references. Similarly, applicants' decision not to discuss differences between the prior art and
3 every claim element, or every comment made by the Examiner, should not be considered as an
4 admission that applicants concur with the Examiner's interpretation and assertions regarding those
5 claims. Indeed, applicants believe that all of the dependent claims patentably distinguish over the
6 references cited. Moreover, a specific traverse of the rejection of each dependent claim is not
7 required, since dependent claims are patentable for at least the same reasons as the independent
8 claims from which the dependent claims ultimately depend.

9 Preliminary Remarks

10 The Examiner's response to applicants' arguments included the following comment: "If
11 Applicant wishes to preclude inclusion of machine instructions by reference, the Examiner
12 recommends that the claims be amended to require the distributed application data (Web Page) and
13 machine instructions to be located in a single file, or a similar recitation which limits the number of
14 files that may be transmitted." Applicants have amended Claims 1, 13, 14, and 21 in accord with
15 the Examiner's suggestion as indicated above. Support for the amendments to claims 1, 13, 14, and
16 21 are provided at least by page 8, lines 24-28, and page 17, lines 13-16 of applicants'
17 specification. Additional support for the amendments to Claims 1, 13, 21, 35, and 42 are provided
18 at least by page 19, lines 18-31, and page 20, Table 2, specifically, the actions identified at times
19 t6-t9 regarding the loading and operation of a monitoring function.

20 The Examiner rejected Claims 1, 13, 14, 21, 35, and 42 over Burman. As noted above,
21 applicants have amended Claim 1, paragraph (c), which now recites, "appending machine
22 instructions that define a performance monitoring function to the distributed application data that
23 were requested and transmitted over the network to the second site *as one data file*" (emphasis
24 added). Burman does not disclose or suggest "appending machine instructions that define a
25 performance monitoring function to [] distributed application data," which are then "transmitted
26 over [a] network to [a] second site *as one data file*," as recited by applicants' amended Claim 1.
27 Instead, Burman specifically requires that "[a] web page sent or served to the user's browser during
28 step 104 will include a link or reference to a rich media file, such as a script (e.g., JavaScript,
29 VBScript) or an IFRAME reference to be fetched by the user's browser during step 106." (Burman,
30 paragraph 47, lines 11 - 16.) Furthermore, Burman makes it clear that "upon receipt by the user's

1 browser of the desired web page served during step 104, the user's browser will send or initiate a
2 *fetch rich media request* during the step 106." (Emphasis added, Burman, paragraph 48, lines 1-4.)
3 Clearly, Burman does not teach or even contemplate "appending machine instructions that define a
4 performance monitoring function to [] distributed application data," which are then "transmitted
5 over [a] network to [a] second site *as one data file*," as recited by applicants' amended Claim 1.
6 For at least this reason, Burman does not anticipate or render obvious the recitation of applicants'
7 Claim 1. Additionally, Claims 13, 14, and 21 have each been similarly amended to recite that
8 machine instructions are appended to distributed application data for transmission as one data file.
9 Therefore, each of Claims 13, 14 and 21 are novel and nonobvious over Burman for at least the
10 same reason as discussed above for Claim 1.

11 Furthermore, paragraph (d) of Claim 1 has been amended to recite that a performance
12 metric is determined "without using the performance monitoring function to request any distributed
13 application data from *any* site, *at least one performance metric being determined in connection*
14 *with timing of events occurring during the transmission of the distributed application data to the*
15 *second site.*" (Emphasis added.) This amendment thus clearly further distinguishes applicants'
16 Claim 1 over Burman, since "at least one performance metric is determined in connection with
17 timing of events occurring during the transmission of the distributed application data to the second
18 site," solely from the "distributed application data that were requested and transmitted over the
19 network to the second site as one data file." Table 2 in applicants' specification details how the
20 times at which events occur is used to determine various performance metrics, providing clear
21 support and understanding for this added recitation to Claim 1. In contrast, Burman discloses that
22 "the rich media script may also cause the user's browser to *fetch or request other images* so that
23 transfer time and/or the user's bandwidth between the user's computer and other device connected
24 to the computer network 22 may be determined." (Burman, paragraph 81, lines 8-10, emphasis
25 added.) And Burman also teaches that "the rich media may initiate or run one or more nested
26 sequences of one or more steps in the method 110 or initiate *a request for content to be served to*
27 *the user's browser.*" (Emphasis added, paragraph 81, lines 14-17 of Burman.) Furthermore,
28 Burman makes it very clear as evidenced by lines 1-22 of the Abstract of the reference that the
29 purpose of the invention disclosed therein is to calculate the bandwidth between devices on a
30 network in order to select which *additional* content will be served to a user's browser (i.e., so that

1 smaller files will be served if the bandwidth is too limited). Simply stated, the disclosure and
2 teaching of Burman is in direct contravention with applicants' amended Claim 1, which recites not
3 only that performance metrics are determined "**without** using the performance monitoring function
4 to request **any** distributed application data from any site," but also recites that a performance or
5 browser monitoring function is determined "*in connection with timing of events occurring during*
6 *the transmission of the distributed application data to the second site*" (emphasis added), and not
7 based upon the timing determined when downloading other data. Therefore, it is impossible to
8 practice Berman's invention according to the recitation of applicants' Claim 1, and Burman actually
9 teaches away from applicants' Claim 1 by requiring additional steps that are contrary to the
10 recitation in applicants' claim. Therefore, for each of these additional reasons, Claim 1 is
11 patentable over Burman.

12 Each of Claims 13 and 21 have also been amended to recite that a performance or browser
13 monitoring function determines performance metrics **without** using the performance or browser
14 monitoring function "to request any distributed application data from any site" and to recite, "*at*
15 *least one performance metric being determined in connection with timing of events occurring*
16 *during the transmission of the distributed application data to the client device*" (emphasis added).
17 Therefore, Claims 13 and 21 are also novel over Burman for the reasons presented above for
18 patentability of Claim 1.

19 Claim 35 has been amended to clarify that "**neither the compound performance metric nor**
20 *the correlated performance metric* [are] *determined using the browser monitoring function to*
21 *request any Web page from any site*" (emphasis added). As discussed above, Burman discloses and
22 teaches that "the rich media script may also cause the user's browser to *fetch or request other*
23 *images* so that transfer time and/or the user's bandwidth between the user's computer and other
24 device connected to the computer network 22 may be determined." (Emphasis added, Burman,
25 paragraph 81, lines 8-10.) Burman does not disclose or suggest any other method to determine
26 "transfer time and/or the user's bandwidth between the user's computer and other device connected
27 to the computer network." Therefore, Burman does not anticipate applicants' Claim 35 or render it
28 obvious, since Burman fails to disclose or suggest what is recited by applicants' Claim 35.
29 Furthermore, Burman explicitly teaches away from applicants' Claim 35, since no alternatives to
30

1 the requesting an additional download are either explicitly taught or suggested by Burman, and the
2 method of Burman cannot be implemented according to the recitation of Claim 35.

3 Claim 42 has been amended to clarify that the "machine instructions that perform a browser
4 monitoring function" are implemented "**without** using the browser monitoring function to request
5 any *further download* from any site, said at least one performance metric including at least one of
6 compound performance metric and a correlated performance metric" (emphasis added). As
7 discussed above, Burman does not disclose or suggest any method to determine "transfer time
8 and/or the user's bandwidth between the user's computer and other device connected to the
9 computer network," that can be accomplished **without** using the browser monitoring function to
10 request a *further download* from a site. Therefore, Burman does not anticipate applicants'
11 Claim 42, since Burman never discloses that which is recited by applicants' Claim 42.
12 Furthermore, Burman explicitly teaches away from applicants' Claim 42, since the recitation of the
13 claim is not explicitly taught or suggested by Burman, and the method of Burman cannot be
14 implemented according to the recitation of Claim 42.

15 Dependent claims that depend from patentable independent claims are patentable for at least
16 the same reasons that the independent claims are patentable. For this reason, claims dependent on
17 each of Claims 1, 13, 21, 35 and 42 are all patentable for each of the reasons presented above. For
18 each of the above reasons, applicants respectfully submit that claims 1-56 are all patentable over
19 the cited art.

20 Claims Rejected under 35 U.S.C. § 103(a)

21 The Examiner has rejected Claims 4, 6, 11, 16, 18, 23, 24, 26, 33, 34, 36, 44, 45, and 47
22 under 35 U.S.C. § 103(a) as being unpatentable over Burman in view of U.S. Patent No. 6,411,998
23 (Bryant et al., hereinafter referred to as "Bryant"). Claims 5, 17, and 25 were rejected under
24 35 U.S.C. § 103(a) as being unpatentable over Burman in view of Bryant and further in view of
25 U.S. Patent No. 5,732,218 (Bland et al., hereinafter referred to as "Bland"). Claims 8, 27, 28, 37,
26 48, 49, 54, and 56 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Burman in
27 view of Bland. The Examiner rejected Claims 9, 20, 30, 39, and 51 under 35 U.S.C. § 103(a) as
28 being unpatentable over Burman in view of a non-patent publication entitled "A Survey of Web
29 Caching Schemes for the Internet," authored by Jia Wang, Cornell Network Research Group,
30 Department of Computer Science, Cornell University, Ithaca, NY (hereinafter referred to as

1 “Wang”). Finally, the Examiner rejected Claim 55 under 35 U.S.C. § 103(a) as being unpatentable
2 over Burman in view of Bland and further in view of Bryant.

3 It is axiomatic that a claim that depends from an allowable claim is also allowable for at
4 least the same reasons. Claims 4, 5, 6, and 11 depend from independent Claim 1, dependent
5 Claims 16, and 18 depend from independent Claim 14, dependent Claims 23, 24, 26, 33, and 34
6 depend from independent Claim 21, and dependent Claims 36, 44, 45, and 47 depend from
7 independent Claim 42. For the reasons stated above, Burman does not teach or suggest the
8 recitation of independent Claims 1, 14, 21, 35, and 42, and Bryant does not provide any teaching or
9 suggestion that would lead one of ordinary skill in the art to achieve applicants’ claimed recitation.
10 Accordingly, the rejection of Claims 4, 6, 11, 16, 18, 23, 24, 26, 33, 34, 36, 44, 45, and 47 as being
11 obvious over Burman in view of Bryant should be withdrawn.

12 Applicants respectfully submit that the rejection of Claims 5, 17, and 25 is unjustified and
13 should be withdrawn. Claim 5 depends from independent Claim 1, Claim 17 depends from
14 independent Claim 14, and Claim 25 depends from independent Claim 21. For at least the reasons
15 discussed above, Burman does not disclose, teach, or even suggest the recitation of Claims 1, 14,
16 and 21, and neither Bryant nor Bland provide any further teaching that would cure this
17 shortcoming. Therefore, Burman in combination with Bryant cannot be a basis for rejecting
18 Claims 5, 17, and 25, which depend from Claims 14, and 21, under 35 U.S.C. § 103. Accordingly,
19 the rejection of Claims 4, 6, 11, 16, 18, 23, 24, 26, 33, 34, 36, 44, 45, and 47 as being obvious over
20 Burman, in view of Bryant, and further in view of Bland should be withdrawn.

21 For similar reasons, the rejection of Claims 8, 27, 28, 37, 48, 49, 54, and 56 is improper and
22 should be withdrawn. Claim 8 depends from independent Claim 1, Claims 27 and 28 depend from
23 independent Claim 21, Claim 37 depends from independent Claim 35, and Claims 48, 49, 54, and
24 56 all depend from independent Claim 42. For at least the reasons discussed above, Burman does
25 not disclose or suggest the recitation of any of Claims 1, 21, 35, and 42, and Bland fails to provide
26 the required teaching or suggestion that would justify rejection of these independent claims.
27 Accordingly, the rejection of Claims 8, 27, 28, 37, 48, 49, 54, and 56 as being obvious over
28 Burman in view of Bland should be withdrawn.

29 Applicants also respectfully submit that the rejection of Claims 9, 20, 30, 39, and 51 is also
30 unjustified. Claims 9, 20, 30, 39, and 51 depend from independent Claims 1, 21, 35, and 42,

1 respectively. For at least the reasons discussed above, Burman does not teach or suggest the
2 recitation of any of Claims 1, 21, 35, and 42, and Wang fails to provide any teaching or suggestion
3 that would justify the rejection of these claims. Therefore, Claims 9, 20, 30, 39, and 51, which
4 respectively depend from Claims 1, 21, 35, and 42, are clearly not obvious over Burman in view of
5 Wang.

6 Finally, the rejection of Claim 55 is unjustified. Claim 55 depends from Claim 42, and for
7 at least the reasons discussed above, Burman, even in combination with Bland, and Bryant, fails to
8 teach or suggest the recitation of Claim 42. Therefore, the combination of Burman, Bland, and
9 Bryant cannot be properly used to reject Claim 55. Accordingly the rejection of Claim 55 as being
10 obvious over Burman in view of Bland, and further view of Bryant should be withdrawn.

11 In view of the preceding remarks, it should be evident that this application is in condition
12 for allowance and should be passed to issue without delay. Should any further questions remain,
13 the Examiner is invited to telephone applicant's attorney at the number listed below.

14 Respectfully submitted,

15
16
17 /ron anderson/
18 Ronald M. Anderson
19 Registration No. 28,829

20 RMA/PJN:elm
21
22
23
24
25
26
27
28
29
30